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REMARKS

Applicant has carefully reviewed the Office Action mailed September 25, 2006. In response to the Office Action, Applicant has amended claims 1, 5-7 and 12. By way of this amendment, no new matter has been added. Claim 8 was previously cancelled. Accordingly, claims 1-7, and 9-21 remain pending in this application. At least for the reasons set forth below, Applicant respectfully traverses the foregoing rejections. Further, Applicant believes that there are also reasons other than those set forth below why the pending claims are patentable, and reserves the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers. Applicant respectfully requests reconsideration of the present application in view of the above amendment, the new claims, and the following remarks.

Claim Rejections – 35 U.S.C. § 112

Claims 5 and 6 were rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps, such omission amount to a gap between the steps. Applicant respectfully traverses the rejection. Specifically, the Examiner points out that the step of determining a torsional acceleration is an essential step in the recitations of claims 5 and 6. Accordingly, claims 5 and 6 have been amended to delete the references to torsional acceleration.

Claim Rejections – 35 U.S.C. § 102

Claims 7, 9, 10, and 18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Eaton Corporation (hereinafter "Eaton"), "Eaton Truck Components Bulletin, TRIB-9701", 1997, including the DAA program. Applicant respectfully traverses the rejection.

Applicant notes that independent claim 7 has been amended to delete the recitation of "determining ... a torsional acceleration." With this amendment, the cited reference does not anticipate independent claim 7. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection.

PAGE 8/12 * RCVD AT 12/26/2006 8:29:15 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-5/20 * DNIS:2738300 * CSID:248 594 0610 * DURATION (mm-ss):01-56

Claim Rejections – 35 U.S.C. § 103

Claims 1-5, 12-15, 17, and 19-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Eaton Corporation (hereinafter "Eaton"), "Eaton Truck Components Bulletin, TRIB-9701", 1997, including the DAA program; in view of *Creger*, US 5,848,371. Applicant respectfully traverses the rejection.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

"The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out by the reference." *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

Independent Claims 1, 7 and 12

Independent claims 1, 7 and 12 positively recite "determining an inertia of the vehicle driveline based on the entered measurements." The Examiner admits that "Eaton fails to expressly disclose determining an inertia of the vehicle driveline." (Non-Final Office Action mailed September 25, 2006, page 6, line 7) The Examiner contends that Creger teaches that "as shown in equation 9, driveline inertia is determined by multiplying I_{MN} and ACCELERATION" (Id. Page 6, lines 12-14) However, and in direct contrast to the assertions by the Examiner, Creger teaches in Equation 9 that torque may be calculated by multiplying I_{MN} and ACCELERATION. (See Creger column 5, lines 56-60, demonstrating that Equation 9 provides "$T_{DRIVELINE-INERTIA-N}$ is the torque..")

Additionally, the Examiner contends that Creger teaches that "the relationship between driveline inertia and ACCELERATION is I_{MN}, which is a calculated constant." (Non-Final Office Action mailed September 25, 2006, page 6, lines 15-16) However, a close reading of Creger reveals

PAGE 9/12 * RCVD AT 12/26/2006 8:29:15 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-5/20 * DNIS:2738300 * CSID:248 594 0610 * DURATION (mm-ss):01-56

that I_{MN} **is inertia** and 'the relationship between torque and ACCELERATION is I_{MN}'. Accordingly, driveline inertia is not taught in Creger to be proportional to acceleration, which is the basis for the Examiner's incorrect conclusion that Equation 9 of Creger teaches determining inertia.

The Examiner is correct in that Creger teaches "I_{MN}, which is a calculated constant." (Non-Final Office Action mailed September 25, 2006, page 6, line 16) However, this specific teaching of Creger clearly demonstrates that Creger teaches that inertia is a constant for the purposes of the torque determination of Creger.

Furthermore, Equation 10 of Creger teaches away from "determining an inertia of the vehicle driveline based on the entered measurements," by illustrating in Equation 10 that inertia is determined by summing lumped inertia constants. Creger does not teach determining an inertia based upon measurements, but based upon known constants for a known driveline configuration. Accordingly, one of skill in the art would recognize that neither Eaton of Creger would be useful in "determining an inertia of the vehicle driveline based on the entered measurements," since neither mention this determination or provide any direction on how to make this determination. Thus, the combination of Eaton and Creger does not teach every limitation of independent claims 1, 7, and 12, as required in *In re Royka*. Dependent claims 2-5, 13-15, 17, and 19-21 are also patentable by being dependent on an allowable base claim.

Motivation

Moreover, the Examiner has not identified any motivation within either Creger or Eaton for the proposed combination, but has supplied a motivation as "to obtain the invention of claim 1 because driveline inertia is proportional to the already determined acceleration." As detailed above, this purported teaching of Creger does not exist in Creger. Further, the contention that inertia is proportional to acceleration is incorrect since inertia is a property of the specific configuration of an item, including geometry and mass, and acceleration of any driveline is purely dependent upon the change in speed and will never be proportional to inertia. (Also note that in Equation 10 of Creger, inertia is *multiplied by* acceleration).

PAGE 10/12 * RCVD AT 12/26/2006 8:29:15 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-5/20 * DNIS:2738300 * CSID:248 594 0610 * DURATION (mm-ss):01-56

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DEC 2 6 2006

Error within Creger

Applicant also notes that the text of Creger relied upon by the Examiner immediately following Equation 9 is incorrect in that Creger states that torsional acceleration is "the second derivative of speed." (Creger, Column 5, lines 62-65) Importantly, one of skill in the art would recognize that torsional acceleration is the ***first*** derivative of speed, and would not likely rely upon Creger for any teachings in light of this glaring error.

Therefore, reconsideration and withdrawal of the rejection is respectfully requested.

Conclusion

In view of the above amendment and remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

It is believed no fees are due with this response. However, if any fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge our Deposit Account No. 18-0013, under Order No. 65856-0025 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

Dated: December 26, 2006

(the 25th falling on a holiday)

Respectfully submitted,

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PAGE 11/12 * RCVD AT 12/26/2006 8:29:15 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-5/20 * DNIS:2738300 * CSID:248 594 0610 * DURATION (mm-ss):01-56